

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated October 12, 2007 are respectfully requested in view of the foregoing amendments and following remarks. Following entry of the amendments set forth herein, claims 1-10, 16-22, 24, and 26-27 are pending in the application.

I. Amendments to the Claims

Claims 1-10, 16-22 and 24 are amended for grammatical clarity

Claim 1 is also amended to incorporate the limitation of claim 11 and to remove the recitation of "a labile ester forming group and a base" and to include the reagent ethyl azadicarboxylate. Support for the reagent is found, for example, on page 10, line 6. Claim 1 is also amended to recite that the citalopram is prepared without isolating an intermediate. Basis is found, for example, at page 3, line 7.

The temperature ranges in claims 19-22 have been amended by replacing the division symbol "+" with "to," which was the intended meaning.

Claims 11-15, 23, and 25 stand cancelled without prejudice to Applicant's right to pursue the subject matter of these claims in a continuing application.

New claim 26 has been added, which finds support in the language of claim 24.

New claim 27 has been added. Support for the language "one pot" can be found, for example, on page 4, lines 1-6.

Claims 11-13, 23, and 25 are canceled without prejudice or disclaimer.

No new matter has been added by these amendments.

II. Rejections under 35 U.S.C. § 112, second paragraph

A. Claims 1, 9, 10-13, 19-22, and 25 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite with respect to the term "a labile ester." As noted above,

the term "labile ester" has been deleted from the claims. Withdrawal of the rejection is requested.

B. Claim 9 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite with respect to the term "orto." The term has been amended to "ortho," which is clearly the intended term. Withdrawal of the rejection is requested.

C. Claim 10 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite with respect to the claimed concentration range (i.e. % weight). Applicants respectfully submit that the concentration of an acid is commonly recited as a percent acid by weight, and that those of skill in the art recognize that acidic concentrations are given as percent by weight of acid in an aqueous media. For this reason, Applicants submit the claim is clear, and withdrawal of the rejection is requested.

D. Claims 11 and 12 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite as a result of failing to recite an essential reagent, in particular ethyl azadicarboxylate. The claims have been amended such that step (b) recites "adding an organic acid, an inorganic acid, or triphenylphosphine and ethyl azadicarboxylate," which presumably addresses the rejection. Withdrawal of the rejection is requested.

E. Claims 19-22 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite in the format of the temperature range. The claims have been amended to reflect more standard temperature range language. Applicants submit that these temperature ranges are apparent upon reading the specification. Withdrawal of the rejection is requested.

III. Rejections under 35 U.S.C. § 101

Claim 1 was rejected under 35 U.S.C. § 101 as allegedly failing to set forth steps and not being a proper process claim.

Claim 1 has been amended to recite process steps. Withdrawal of the rejection is requested.

IV. Rejections under 35 U.S.C. § 112, first paragraph

A. Claims 12 and 13 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being supported by an enabling disclosure with respect to all the claimed esters.

Claims 12 and 13 have been canceled. Withdrawal of the rejection is requested.

B. Claims 24 and 25 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being supported by an enabling disclosure with respect to the claimed magnesium alkoxide intermediate. This rejection is respectfully traversed.

The source of the sample used in the NMR experiment is described on page 7, in the final paragraph beginning "NOTE 1: ". The results of the NMR experiment appear reasonable on their face and make the point that that an intermediate is produced that lacks the hydroxyl group at position 3.

Applicants submit that in view of the teachings of the specification combined with what is known about the underlying chemistry, there is adequate enabling support for the claimed intermediate. Withdrawal of the rejection is respectfully requested.

V. Rejections under 35 U.S.C. § 103

Claims 1-10 and 15-25 were rejected as allegedly obvious over EP 017943 (Bosgeso).

Claims 1 and 12-25 were rejected as allegedly obvious over USPN 4,943,590 (Bosgeso).

These rejections are respectfully traversed.

EP 017943 and USPN 4,943,590 describe methods for performing the dehydration of a diol, both methods requiring discrete reaction steps for forming an intermediate and then affecting cyclization on the isolated intermediate.

As noted above, the pending claims recite a process wherein an intermediate is not isolated. Accordingly the cited documents do not show or suggest all of the claim features.

Nor would it be obvious to modify the cited documents to arrive at the claimed process, because there is nothing in the documents to modify the processes to arrive at the claimed process. While the Examiner asserts that the present process and compositions would be obvious in view of EP 017943 or USPN 4,943,590, no secondary references have been cited to correct the admitted defects in the references. Thus the rejections rely on the conclusory assertion that the claimed process and composition are obvious in view of the prior art, without factual support for the assertion. M.P.E.P § 2143 teaches that a mere statement that modification of the prior art to arrive at the claimed invention is not sufficient to establish a *prima facie* case of obviousness without an objective reason to combine the teaching of reference. In this case, there are no references to combine, only the Examiner's assertion that the invention would be obvious in view of either reference.

For at least these reasons, Applicants submit that a *prima facie* case of obviousness has not been established, and the rejections should be withdrawn. Should additional references be added to the rejection, Applicants request that the next Office Action not be made final.

VI. Conclusion

In view of the foregoing, Applicant submit that the claims are fully in condition for allowance. A Notice of Allowance is, therefore, respectfully requested.

If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (650) 838-4402.

Respectfully submitted,

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